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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,234	09/09/2003	Seppo Reino Keronen	00169.001469.3	8842
5514	7590	12/17/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			FUREMAN, JARED	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/657,234

Applicant(s)

KERONEN ET AL.

Examiner

Jared J. Fureman

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mf

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-95 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 46-95 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/414,558.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/13/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of the IDS, drawings, and amendment, filed on 9/13/2004. Claims 46-95 are pending.

Drawings

1. The drawings were received on 9/13/2004. These drawings are acceptable to the examiner.

Specification

2. Applicant states that the amendment contains amendments to the specification (see the third paragraph on page 16, of the amendment filed on 9/13/2004), however, the amendments to the specification do not appear in the file (it appears as though page 2 of the amendment is not in the file). Would applicants please provide another copy of the amendments to the specification?

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 46, 48-53, 56-67, and 70-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Combaluzier (WO 95/35534, cited by applicant) in view of Kitagawa et al (US 6,032,857, cited by applicant).

Combaluzier teaches a system, method, and computer program including a card (3) adapted to be inserted into a card reader/computer device (control housing 1) that

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communicates with another device (an electrical apparatus, for example, radios, electrical communication apparatus with station search, digital telephone networks, bar code readers, see page 8, lines 13-21), the card comprising: selectable indicia (14) on a surface of the card, a storage device (chip 18) storing data associated with the indicia wherein selection of one of the indicia while the card is inserted into the reader causes accessing of the corresponding data in the card, the system necessarily includes a card customizing apparatus for customizing the card (for example: an apparatus at the place of manufacture of the card), the card customizing apparatus comprising a processor for handling the first and second information, the processor being configured to write the data into the memory of the card (the information is written at the time of manufacture of the card), wherein the card storing the data is printed by a writer device connected to the card customizing apparatus (the indicium 14 is printed on the card at the time of manufacture), wherein the card reader obtains the selected information dependent upon selection of the indicium (when the user presses one of the keys 13) and sends the second information to the other device, the card reader includes a processor (9) for obtaining the data from the storage device on the card (see figures 1, 2, 5-9, page 3 line 26 - page 4 line 21, page 5 lines 1-7, page 6 line 14 - page 9 line 27).

Combaluzier fails to specifically teach the card reader communicating with a computer device, storing memory references relating to an external memory device, accessing of the memory references causes accessing of corresponding data/service stored in the external memory device using the memory reference, wherein the computer device receives the selected memory reference from the card via the card

reader and communicates with the external memory device over a communication network using the selected memory reference to access dependent upon a selected indicium the corresponding data, wherein the external memory device is a server, the memory references being associated with corresponding web pages, the memory references being URL's, the memory references being telephone numbers.

Kitagawa et al teaches a system and method including a card (10) adapted for insertion into a card reader that communicates with a computer device (for example: electronic wallet 31, personal computer 32, or telephone 34), the card comprising a memory (103) storing memory references (for example: telephone numbers or network addresses) relating to an external memory device, wherein accessing the memory references causes accessing of corresponding data/services stored in the external memory device using the memory reference, a processor (for example: a processor of a store's POS terminal) configured to write the memory references into the storage device of the card, wherein the computer device receives the selected memory reference from the card via the card reader and communicates with the external memory device over a communication network (7) using the selected memory reference to access the corresponding data/services, wherein the external memory device is a server (in that the external memory device serves information to the users), the memory references being associated with corresponding web pages (network addresses), the memory references being URL's (network addresses), the memory references being telephone numbers (see figures 1-3, 7, 8, column 1 lines 36-44, 54-60, column 2 lines 21-30, 42-

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52, column 3 line 43 - column 4 line 64, column 6 line 61 - column 7 line 4, column 7 lines 30-35, column 8 lines 3-43, and column 10 lines 1-32).

In view of Kitagawa et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system and method as taught by Combaluzier, the card reader communicating with a computer device, storing memory references relating to an external memory device, accessing of the memory references causes accessing of corresponding data/service stored in the external memory device using the memory reference, wherein the computer device receives the selected memory reference from the card via the card reader and communicates with the external memory device over a communication network using the selected memory reference to access dependent upon a selected indicium the corresponding data, wherein the external memory device is a server, the memory references being associated with corresponding web pages, the memory references being URL's, the memory references being telephone numbers, in order to provide large amounts of information to the user while using a minimum amount of memory on the card (see column 8 lines 19-43 of Kitagawa et al).

5. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over Combaluzier as modified by Kitagawa et al as applied to claim 46 above, and further in view of Masuzawa et al (US 5,015,830, cited by applicant).

Combaluzier as modified by Kitagawa et al fails to specifically teach the first information and the second information being inputted from a keyboard.

Masuzawa et al teaches the use of a keyboard (21) for inputting data to be written to a card (50) (see figures 1, 5, 6, column 1 lines 11-20, and column 5 lines 21-30).

In view of Masuzawa et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Combaluzier as modified by Kitagawa et al, the first information and the second information being inputted from a keyboard, in order to utilize a simple and well established means/method of entering data to be stored in a card.

6. Claim 54, 55, 68, and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Combaluzier as modified by Kitagawa et al and further in view of Cohn et al (US 6,308,202 B1, cited by applicant).

The teachings of Combaluzier as modified by Kitagawa et al have been discussed above. Combaluzier also teaches the card reader having a transparent touch sensitive membrane (the keys 13 are made of a touch sensitive membrane) through which a plurality of indicia (14) of an inserted card (3) are visible (see figures 1, 2, 5-9, page 3 line 26 - page 4 line 21, page 5 lines 1-7, page 6 line 14 - page 9 line 27).

Combaluzier as modified by Kitagawa et al fails to specifically teach the computer device being a set top box having an application to provide a service, the application being loaded on the set top box, and a display that displays a web page.

Cohn et al teaches a control unit (28) that communicates with a computer device (22), the control unit sending information to the computer device, the computer device receiving the information from the control unit and using the information to obtain a

service via a communication line/computer network (32, 34, 10) from an external site (a site connected to the Internet 10), wherein the computer device is a set top box having an application to provide the service, the application being loaded on the set top box, the set top box is connected to the Internet (10), a display (24) that displays a web page (see figures 1-3, column 3 line 17 - column 4 line 31).

In view of Cohn et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the system as taught by Combaluzier as modified by Kitagawa et al, the computer device being a set top box having an application to provide a service, the application being loaded on the set top box, and a display that displays a web page, in order to provide the ability to use the card reader to control a set-top box, in addition to the computer devices as taught by Combaluzier as modified by Kitagawa et al, thereby increasing the versatility/functionality of the system.

Response to Arguments

7. Applicant's arguments filed 9/13/2004 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually (for example: Combaluzier does not teach references to an external memory device and Kitagawa et al does not teach selectable indicia on the surface of the card, see pages 17-18 of the amendment filed on 9/13/2004), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck &*

Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the Combaluzier reference is being relied upon for a teaching of a card having selectable indicia on the surface of the card and stored memory references associated with the indicia.

Kitagawa et al is being relied upon for teaching a card storing memory references relating to an external memory device, in order to allow the card user access to a large amount of information while only using a small amount of memory on the card. One of ordinary skill in the art at the time of the invention would have been motivated by Kitagawa et al's teachings to combine the storage of memory references relating to an external memory device with the system as taught by Combaluzier, in order to allow the card user to gain access to a larger amount of information than is able to be stored directly on the card (see column 1 lines 54-60, column 2 lines 21-30, 42-52, column 7 lines 30-35, and column 8 lines 3-43, of Kitagawa et al). Thus, it is the combined teachings/suggestions of the references that meet the claimed invention.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (571) 272-2391. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jared J. Fureman
Jared J. Fureman
Examiner
Art Unit 2876

December 4, 2004